IV. Claims 18-20 drawn to a method for identifying a molecule which recognizes and binds an allosteric site on DCMTase, classified in class 435, subclass 6.

In response, Applicants elect Group I, namely claims 1-10.

However, Applicants do so with traverse. Applicants dispute the assertion by the Office that the four claim groups involve separate and distinct inventions.

35 U.S.C. §121 provides that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." M.P.E.P. §802.01 deviates from the plain meaning of "independent and distinct" by interpreting "and" to mean "or". The Patent Office relies on the absence from the legislative history of anything contrary to this interpretation as support for their position that "and" means "or". Applicants respectfully note that this position is contrary to the rules of statutory construction. Restriction between two dependent inventions is not permissible under the plain meaning of 35 U.S.C. §121.

The Examiner does not assert that the inventions of the four claim groups are independent. Rather, the Examiner alleges that the inventions of the four claim groups are distinct because they are directed to product and process of use, and because each of the methods identified above is classified in a different art area. Applicants assert that restriction is improper because separate significant search efforts should not be necessary to examine Groups I-IV of the subject application.

Applicants further urge the Examiner take into consideration that the subject matter of each of the claim groups is linked by a common inventive concept, the discovery that a synthetic oligonucleotide comprising a C-5 methylcytosine recognizes and binds an allosteric site on DCMTase and thereby provides methods for inhibiting methylation of DNA and for treating cancer.

According to M.P.E.P. §803, there are two criteria for a proper restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met.

Applicants assert that a search into prior art with regard to the invention of the different groups is so related that separate significant search efforts should not be necessary. Accordingly,

there is no serious burden on the Examiner to collectively examine the different claim groups of the subject application. Therefore, restriction is not proper under M.P.E.P. §803.

At the very least, a search directed to the method of independent claim 11, which is a method of inhibiting methylation of DNA comprising contacting a DCMTase with a synthetic inhibitor molecule so as to form an enzyme/synthetic inhibitor molecule complex in the presence of the DNA, wherein the synthetic inhibitor molecule comprises a C-5 methylcytosine which recognizes and binds an allosteric site on DCMTase, thereby inhibiting DNA methyltransferase activity, would be co-extensive with a search directed to the method of independent claim 12, which is a method of inhibiting proliferation of cancer cells by administering a synthetic inhibitor molecule that inhibits methylation of DNA in the same manner. Likewise, such a search would be co-extensive with a search directed to the method of independent claim 18, which is directed to a method of identifying molecules that recognize and bind an allosteric site on DCMTase.

Consequently, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement. It is also submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP

Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: 20 August 2001

By: _____
Name: Karen S. Canady
Reg. No.: 39,927

KSC/sjm/amb
G&C 30794.30-US-WO